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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,998	06/17/2005	Jean-Marie Bernard	0076144-000004	1195

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EXAMINER

CAMERON, ERMA C

ART UNIT	PAPER NUMBER
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1715

NOTIFICATION DATE	DELIVERY MODE
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06/03/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com
offserv@bipc.com

Office Action Summary	Application No. 10/539,998	Applicant(s) BERNARD ET AL.	
	Examiner /Erma Cameron/	Art Unit 1715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10, 17, 28, 29 and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed does not contain a disclosure that "...composition is not crosslinkable for at least 8 hours...". Page 2, lines 10-17 states that the composition has a lifetime at least equal to 8 hours, but does not state that there is no crosslinking during the 8 hours.

The applicant is requested to cancel all new matter.

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3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 14, 21, 25 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claims 14, last line and claim 25, last line and claim 33, last line: there is no antecedent basis for “blocked isocyanate functional group”.

b) Claim 21, second last line: “polyol is provided is a second container” does not make sense.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 62 - 164049.

See the Abstracts and translation.

'049 teaches making a coating with aliphatic HMDI, 2-(m)ethylimidazole as blocking group, and a polyol. There may be other imidazoles as blocking agent, as well as other species of blocking agent. The coating is dried at 70 C after application. The drying time is not given, but it would have been obvious to optimize the drying time thru no more than routine experimentation.

The limitation of at least 3.5 C of claims 14, 25 and 33 is met because the imidazole has 3 C and the methyl substituent has 1 C.

'049 does not disclose that when the imidazole is used as a blocking agent with other species of blocking agents that it represents >50%, but it would have been obvious to optimize the composition by selecting the optimal mix of blocking agents, as the blocking agents are important in the curing action of the composition.

See Abstracts and pages 5, 7 and Examples of translation.

7. Claims 10-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flosbach et al (6013326).

'326 teaches a coating composition that comprises a hydroxy resin, and an isocyanate such as aliphatic HDI that may be blocked with 2-methylimidazole or other conventional blocking agents, and which is dried at 80-160 C for 20-40 minutes. The limitation of at least 3.5 C of claims 14, 25 and 33 is met because the imidazole has 3 C and the methyl substituent has 1 C.

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'326 does not disclose that when the imidazole is used as a blocking agent with other species of blocking agents that it represents >50%, but it would have been obvious to optimize the composition by selecting the optimal mix of blocking agents, as the blocking agents are important in the curing action of the composition.

See Abstract; 4:33-5:49; 7:45-8:18

8. Claims 10-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nasar et al, Polymer International, 48, pp 614-620, 1999.

Nasar teaches reacting aliphatic HMDI with 2-methylimidazole or benzimidazole to block the isocyanate group, followed by reaction with a polyol (see especially pages 615 and 620).

The limitation of at least 3.5 C of claims 14, 25 and 33 is met because the imidazole has 3 C and the methyl substituent has 1 C.

The curing conditions are reported to be less than 160 C for 30 minutes (page 614).

Nasar does not disclose that when the 2-methylimidazole is used as a blocking agent with other species of blocking agents that it represents >50%, but it would have been obvious to optimize the composition by selecting the optimal mix of blocking agents, as the blocking agents are important in the curing action of the composition.

See in particular the Abstract, and pages 615-616.

9. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 60 - 040121.

See Abstracts and translation.

‘121 teaches a coating composition of a polyol and HMDI blocked with 2-isopropyl or 2-n-butyl-imidazole. Because ‘121 uses the same aliphatic isocyanate and same type of blocking agent as applicant does, the potlife and stability would inherently be the same as claimed by applicant. Moreover, there is no indication in ‘121 that the composition is not stable.

10. Claims 10-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yukawa et al (5274045).

‘045 teaches a composition of an aliphatic isocyanate such as hexamethylene diisocyanate (3:20-40) blocked with 2-ethyleimidazole or other blocking agents (5:48-6:11) that is reacted with a hydroxyl containing monomer in a process B (5:16-25). The polymerization temperature is 50-100 C (7:47-55). When heated at 50-200 C, the blocking group is released and the isocyanate group can react with hydroxyl groups (8:61-68). The composition is stable and shows no gelation on storage (9:1-4; 9:56-64). See the Table on col 13-14, showing good storage stability..

Because ‘045 uses the same aliphatic isocyanate and same type of blocking agent as applicant does, the potlife and stability would inherently be the same as claimed by applicant.

‘045 does not disclose that when the 2-methylimidazole is used as a blocking agent with other species of blocking agents that it represents >50%, but it would have been obvious to

optimize the composition by selecting the optimal mix of blocking agents, as the blocking agents are important in the curing action of the composition.

Response to Arguments

11. Applicant's arguments filed 3/18/2010 have been fully considered but they are not persuasive.

The applicant has argued for all the prior art rejections of paragraphs 6, 7 and 8 that the prior art references do not disclose that their compositions are not crosslinkable for at least 8 hours and physically stable. It is the examiner's position that because the references in paragraphs 6, 7 and 8 above use the same aliphatic isocyanate and the same blocking agents as applicant uses, that the compositions of these references inherently possess the properties of >8 hour pot life and physical stability.

Moreover, there is no indication in any of the three references that their compositions do not have physical stability.

As explained in paragraphs 9 and 10, this argument also applies to the compositions of JP 60-040121 and Yukawa et al (5274045).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Erma Cameron/ whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erma Cameron/
Primary Examiner
Art Unit 1715

May 26, 2010